

REMARKS

Claims 1-22 and 46-51 are pending in the present application. By this Amendment, previously presented claims 12, 18-19 and 49-51 are amended. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendment and the following remarks.

I. Formal Matters:

Claim Rejections Under 35 U.S.C. § 112

Previously presented claims 1-22 and 46-51 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

The Office Action specifically rejects claims 1-22 and 46-51 due to the use of the term “birefringent” to describe multi-layer optical films recited in independent claims 1, 18 and 46. The Office Action considers the addition of the term “birefringent” to be “new matter” under 35 U.S.C. § 112, first paragraph. Applicants disagree.

Applicants note that non-metallic multi-layer optical films suitable for use in the present invention are disclosed on page 13, lines 11-21 of the original specification, which discloses:

Suitable optical sheets comprise a non-metallic multi-layer optical film such as, for example, that described in U.S. Patents Nos. 6,207,260; 6,157,490; 6,049,419; 5,882,774; 5,360,659; 5,223,465; 5,103,557 and 5,103,337 (RE 34,605) and in PCT Publications Nos. WO 99/36248 and WO 01/96104, and U.S. Patent Application Serial No. 60/261942, entitled MULTILAYER INFRARED REFLECTING FILM WITH HIGH AND SMOOTH TRANSMISSION IN VISIBLE WAVELENGTH REGION AND LAMINATE ARTICLES MADE THEREFROM and filed January 15, 2001, all of which are incorporated herein by reference in their entirety. Suitable optical sheets of the present invention may include, but are not necessarily limited to, infrared reflecting films, polarized films, non-polarized films, multi-layer films, colored or tinted films, and decorative films.

Every reference cited in this portion of Applicants’ original specification discloses non-metallic birefringent multi-layer optical films. See, for example, U.S. Patents No. 6,207,260, column 16, lines 3-34; U.S. Patents No. 6,157,490, column 12, line 36 to column 13, line 28, and column 18, line 28 to column 19, line 38; U.S.

Patents No. 6,049,419, column 3, line 66 to column 4, line 30, column 5, lines 4-29, column 9, line 56 to column 11, line 13, and claims 1-8; U.S. Patents No. 5,882,774, Abstract, column 1, lines 19-63, and column 9, line 46 to column 13, line 6; U.S. Patent Application Publication No. 2004/0004778 (which corresponds to U.S. Provisional Patent Application No. 60/261942), paragraphs 0005 and 0084-0087; and International Application Publication No. WO01/96104, Abstract. Each of the references disclosed on page 13, lines 11-21 of the original specification has been incorporated by reference in their entirety into the original specification.

For at least the reasons given above, it is respectfully submitted that Applicants' use of the term "birefringent" to describe multi-layer optical films in independent claims 1, 18 and 46 is fully supported in the original specification and does not constitute "new matter" under 35 U.S.C. §112, first paragraph. Accordingly, Applicants respectfully request withdrawal of this rejection.

II. Prior Art Rejections:

Rejection of Previously Presented Claims 1-11, 46-49 and 51 Under 35 U.S.C. §103(a) in View of Gajewski In Combination With McGurran

Previously presented claims 1-11, 46-49 and 51 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,208,080 to Gajewski et al. (hereinafter, "Gajewski") in view of U.S. Patent No. 6,811,867 to McGurran et al. (hereinafter, "McGurran"). This rejection is respectfully traversed.

Applicants respectfully submit that McGurran is disqualified art under 35 U.S.C. §103(c). The American Inventors Protection Act of 1999 (AIPA) disqualified prior art references under 35 U.S.C. §102(e) if (i) the prior art reference was a patent application filed on or after November 29, 1999, and (ii) the prior art reference and the pending patent application were commonly owned by a person or company at the time of the invention of the pending patent application.

U.S. Patent No. 6,811,867 (McGurran) issued from a patent application filed on August 08, 2000. Further, Applicants submit that the present application, U.S. Patent Application Serial No. 10/038,642, and U.S. Patent No. 6,811,867 to McGurran were, at the time the invention of U.S. Patent Application Serial No. 10/038,642 was

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made, owned by the 3M Company. See, MPEP §706.02(I)(2)(II), "Establishing Common Ownership."

Given that McGurran is not a proper reference under 35 U.S.C. §103(c), Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 12-22 and 50 Under 35 U.S.C. §103(a) in View of Gajewski In Combination With McGurran and Frost

Previously presented claims 12-22 and 50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gajewski in view of McGurran, and further in view of U.S. Patent No. 6,352,754 to Frost et al. (hereinafter, "Frost"). This rejection is moot for the reasons given above.

III. Conclusion:

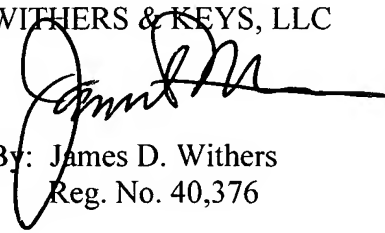
For at least the reasons given above, Applicants submit that claims 1-22 and 46-51 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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